

### **Remarks**

This Amendment is provided in response to the Final Office Action (Paper No. 5) mailed June 6, 2003, which rejected claims 2, 4-7, 11-16, 18-20 and 22-25 and allowed claims 26-37. In response, the Applicants have amended the claims to obviate the rejections and to correct minor editorial problems, and added new claim 38. These amendments are proper under Rule 1.116, do not introduce new matter, and will not provide an undue burden upon the Examiner.

### **IDS Form PTO/SB/08A**

The Applicants gratefully acknowledge receipt of the IDS form initialed by the Examiner.

### **Allowable Subject Matter**

The Applicants gratefully acknowledge the allowed subject matter of claims 26-37.

### **Amendment of Claims 27 and 32**

These claims were amended to correct minor editorial problems.

### **Rejection of Claim 16 Under 35 USC 112**

Claim 16 was rejected because the Examiner found the phrase "operatively adaptively substantially" to be indefinite. The Applicants respectfully traverse the rejection on the basis that each of these terms has a well-known and widely-used

common meaning in claim drafting, and the combination thereof is clearly the cumulative meaning of the individual meanings. However, the Applicants have amended claim 16 to delete the terms "adaptively" and "substantially" from the combination so that the claim now reads in part: "*defining opposing sides of the channel to operatively span the second member.*" This amendment is made only to more particularly point out and distinctly claim that which the Applicants consider to be the patentable subject matter of his invention. Reconsideration and withdrawal of the present rejection of claim 16 are respectfully requested.

#### **Rejection Under 35 USC 102(b) Over Gee '976**

##### **Claim 2**

The Examiner maintained the rejection of claim 2 over the teaching of Gee '976, on the basis that it allegedly meets the structure of claim 2 and thus alleged inherently performs the intended use.

The Applicants traverse the rejection on the basis it is misplaced. In rejecting claim 2, the Examiner totally ignores at least two explicit limitations because they involve relationships with members that are set forth in the preamble. First, claim 2 recites "*defining a channel that is receivingly engageable with and adaptively substantially spans the second member....*" Second, claim 2 recites "*permitting freedom of movement between the guide and the second member in a sliding relationship during the displacement between the members along the operative disposition of the second member longitudinal axis.*"

By first ignoring these limitations, the Examiner then finds the cited reference "meets the structure" by a comparison to only those limitations not ignored. On this basis the Examiner concludes the cited reference must inherently perform the intended use because it meets the structure. This method of claim construction is without basis in the law.

To reiterate from the Amendment filed on March 17, 2003, where preamble language is directed to an intended use of the apparatus, the stated intended use must result in a structural difference between the claimed invention and the cited reference in order to patentably distinguish the claimed invention from the cited reference. However, if the cited reference structure is capable of performing the intended use, then it meets the claim. (MPEP 2111.02) (Amendment of 3/17/2003, pg. 8)

As for the former, the structural differences relating to these ignored limitations are clear. First, the clip of claim 2 is adapted to span the second member. That is, the span of the channel must be substantially the same as the width of the second member. In FIG. 1 of the present invention, for example, the channel 126 defined between the opposing arms 122, 124 spans the web 128 of the second member 104. Contrarily, the channel 5 of Gee '976 extends only so far as the material thickness of the clip, and would thereby make only point contact with the web 128. (see Amendment of 3/17/2003, page 9) Thus, the structural difference is clearly seen in comparing the span of the channel 126 of the present invention as compared to the channel 5 of Gee '976. /

Second, the clip of claim 2 is adapted to constrain movement between the members so as to permit freedom of movement along the second member longitudinal axis. That is, the channel must be directed to permit movement of the second member

along its longitudinal axis. In FIG. 2 of the present invention, for example, reference number 131 clearly indicates the directions along which the second member web 128 is permitted to move, which is coincident with the second member 104 longitudinal axis. Contrarily, in FIG. 3 of Gee '976 the folded-over tabs 7,8 cooperate with the tab 3 to prevent movement along the "second member 13" longitudinal axis. Rather, the arrangement of Gee '976 only permits lateral movement of the second member 13. Thus, the structural difference is clearly seen in comparing the longitudinal freedom of movement of the second member 104 within the channel 126 in the present invention as compared to the lateral freedom of movement of the second member 13 within the channel 5 of Gee '976.

As for the latter, Gee '976 is not capable of performing the intended use. As discussed in Applicants' amendment of 3/17/2003, there is no conceivable way of employing the apparatus of Gee '976 to achieve the intended use of the present invention as claimed in claim 2. (see Amendment of 3/17/2003, pages 10-11) As discussed in detail in the Amendment of 3/17/2003: first, the folded-over tabs prevent displacement along the second member longitudinal axis; second, the slots do not span the second member; third, the foldable tabs lack the structural integrity necessary to provide lateral support to the longitudinal member during displacement.

Accordingly, the present rejection under Section 102 over Gee '976 is misplaced because it ignores structural limitations set forth in the preamble as well as limitations explicitly recited in the claim that are not disclosed by Gee '976. Reconsideration and withdrawal of the present rejection are respectfully requested.

Claims 2, 4-7, 11, and 12

Claims 2, 4-7, 11, and 12 are dependent claims depending ultimately from independent claim 2 which is allowable for the reasons above. These claims are allowable as dependent claims that depend from an allowable independent claim and provide additional limitations thereto. Reconsideration and withdrawal of the present rejection of these claims are respectfully requested.

#### Claim 16

The Examiner maintained the rejection of claim 16 over the teaching of Gee '976, on the basis that it allegedly meets the structure of claim 2 and thus alleged inherently performs the intended use.

The Applicants traverse the rejection on the basis it is misplaced. In rejecting claim 16, the Examiner simply ignores at least one recited limitation because it involves relationships with members that are not positively claimed. Particularly, claim 16 (currently amended) recites "bearing surfaces defining opposing sides of the channel to operatively span the second member...."

By first ignoring this recited limitation, the Examiner then finds the cited reference "meets the structure" by a comparison to only those limitations not ignored. On this basis the Examiner concludes the cited reference must inherently perform the intended use because it meets the structure. This method of claim construction is without basis in the law.

To reiterate from the Amendment filed on March 17, 2003, where preamble language is directed to an intended use of the apparatus, the stated intended use must result in a structural difference between the claimed invention and the cited reference in order to patentably distinguish the claimed invention from the cited reference. However,

if the cited reference structure is capable of performing the intended use, then it meets the claim. (MPEP 2111.02) (Amendment of 3/17/2003, pg. 8)

As for the former, the structural differences are clear from this ignored claim limitation. Particularly, the clip of claim 2 is adapted to span the second member. That is, the span of the channel must be substantially the same as the width of the second member. In FIG. 1 of the present invention, for example, the channel 126 defined between the opposing arms 122, 124 spans the web 128 of the second member 104. Contrarily, the channel 5 of Gee '976 extends only so far as the material thickness of the clip, and would thereby make only point contact with the web 128. (see Amendment of 3/17/2003, pages 12-13) Thus, the structural difference is clearly seen in comparing the span of the channel 126 of the present invention as compared to the channel 5 of Gee '976.

As for the latter, Gee '976 is not capable of performing the intended use. As discussed in Applicants' amendment of 3/17/2003, there is no conceivable way of employing the apparatus of Gee '976 to achieve the intended use of the present invention as claimed in claim 16. (see Amendment of 3/17/2003, pages 10-11) As discussed in detail in the Amendment of 3/17/2003: first, the folded-over tabs prevent displacement along the second member longitudinal axis; second, the slots do not span the second member; third, the foldable tabs lack the structural integrity necessary to provide lateral support to the longitudinal member during displacement.

Accordingly, the present rejection under Section 102 over Gee '976 is misplaced because it ignores structural limitations set forth in the preamble as well as a limitation

explicitly recited in the claim that are not taught by Gee '976. Reconsideration and withdrawal of the present rejection are respectfully requested.

#### Claims 18-20 and 22-25

Claims 18-20, and 22-25 are dependent claims depending ultimately from independent claim 16 which is allowable for the reasons above. These claims are allowable as dependent claims that depend from an allowable independent claim and provide additional limitations thereto. Reconsideration and withdrawal of the present rejection of these claims are respectfully requested.

#### Rejection of Claims 13-15 Under 35 USC 103(a)

These claims are allowable as dependent claims depending from an allowable independent claim 2, for reasons above, and providing additional limitations thereto. Reconsideration and withdrawal of the present rejection are respectfully requested.

#### New Claim 38

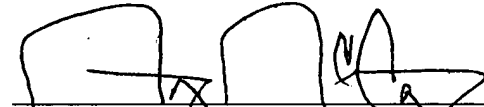
New claim 38 explicitly recites the opposing arms being noncoplanar, which the Examiner has found to be a patentably distinct limitation over the art of record.

#### Conclusion

This is intended to be a complete response to the Final Office Action mailed June 6, 2003. The Amendments contained herein are proper under Rule 1.116, do not add new matter, and do not place an undue burden or require additional searching by the Examiner. All rejections and objections are obviated such that the pending claims are in

condition to pass to allowance. The Examiner is encouraged to contact the Applicants' representative below for any matter that might further facilitate prosecution on the merits.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Mitchell K. McCarthy', written over a horizontal line.

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